



UNITED STATES PATENT AND TRADEMARK OFFICE

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OFFICE OF PETITIONS

In re Application of :
Ho et al. : DECISION ON PETITION
Application No. 10/828,761 :
Filed: April 20, 2004 :
Atty Docket No. 1176/209 :

This is a decision on the PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNAVIDABLY UNDER 37 CFR 1.137(a) filed September 10, 2008.

The petition under 37 CFR 1.137(a) is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)" or "Renewed Petition under 37 CFR 1.137(b)," as appropriate. Extensions of time are permitted under § 1.136(a).

The above-identified application became abandoned for failure to timely file an appeal brief and brief fee. A final Office action was mailed on October 9, 2007. This Office action set a three-month shortened statutory period for reply, with extensions of time obtainable under § 1.136(a). Amendments were filed in reply on December 10, 2007 and on January 9, 2008 with an appropriate extension of time. However, the examiner determined that neither of these replies placed the application in condition for allowance. (See Advisory Actions mailed December 27, 2007 and February 4, 2008). On February 11, 2008, applicant filed a Notice of Appeal and Request for pre-appeal Brief Conference. This further reply was made timely by an

additional petition for extension of time. On March 14, 2008, a Notice of Panel Decision was mailed. Therein, a one-month period, with extensions of time obtainable under 37 CFR 1.136(a), was set to file an appeal brief and brief fee. No appeal brief and brief fee considered timely filed and no extension of time considered obtained, the application became abandoned effective April 15, 2008. A courtesy Notice of Abandonment was mailed on August 19, 2008.

In response, applicant promptly filed the instant petition based on unavoidable delay. Applicant contends that a timely response was filed by facsimile transmission on April 14, 2008. In support thereof, applicant submits a copy of the response as filed, a 19-page appeal brief; a copy of their facsimile confirmation sheet confirming successful transmission; and a copy of the USPTO auto-reply acknowledging receipt of a 19-page facsimile transmission sent to 571-273-8300 (the Office's centralized facsimile number).

A grantable petition under § 1.137(a) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee set forth in 37 C.F.R. § 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to § 1.137(d). No terminal disclaimer is required.

The petition includes a proposed required reply in the form of an appeal brief and payment of the petition fee. No terminal disclaimer is required to revive this application. The petition is not grantable because the instant petition fails to meet requirements (1) and (3) above.

With respect to requirement (1), the required reply is an appeal brief and the brief fee. This petition does not include the brief fee or an authorization to charge the brief fee to a Deposit Account.

With respect to requirement (3), decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith, 671 F.2d at 538, 213 U.S.P.Q. at 982. Nonetheless, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32.

Petitioner's evidence and arguments have been considered and it is concluded that the requirements of 37 CFR § 1.8(b) have been met with respect to showing that an appeal brief was timely filed on April 14, 2008. An appeal brief is considered timely filed by facsimile transmission pursuant to 37 CFR § 1.6(d) on April 14, 2008. However, petitioner has not established that the appeal brief was accompanied by the required brief fee set forth in 37 CFR 41.20(b)(2). Further, no general authorization to pay any such required fee is present in the application. Accordingly, it is concluded that the application is properly held abandoned for failure to timely submit the appeal brief and brief fee. Under these circumstances, withdrawal of the holding of abandonment is not warranted.

Moreover, having not made an adequate showing of timely receipt of a proper reply, including the appeal brief and brief fee, the petition cannot be granted under §1.137(a).

It is noted that petitioner requests on petition to revive under 37 CFR 1.137(a) that the Office withdraw holding of abandonment and waive the petition fee. However, unless the circumstances warrant the withdrawal of the holding of abandonment (i.e., it is determined that the application is not properly held abandoned), the payment of a petition fee to obtain the revival of an abandoned application is a statutory prerequisite to revival of the abandoned application, and cannot be waived. In addition, the phrase "[o]n filing" in 35 U.S.C. 41(a)(7) means that the petition fee is required for the filing (and not merely the grant) of a petition under 37 CFR 1.137. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6 (1982), reprinted in 1982 U.S.C.C.A.N. 770 ("[t]he fees set forth in this section are due on filing the petition"). Therefore, the Office: (A) will not refund the petition fee required by 37 CFR 1.17(l) or 1.17(m), regardless of whether the petition under 37 CFR 1.137 is dismissed or denied; and (B) will not reach the merits of any petition under 37 CFR 1.137 lacking the requisite petition fee. See MPEP 711.03(c).

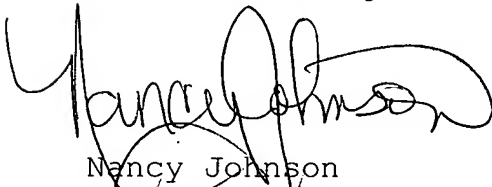
Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
ATTN: NANCY JOHNSON
SENIOR PETITIONS ATTORNEY

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Nancy Johnson", with a large, stylized loop at the end.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions